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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,351	12/04/2003	Randy Miller	1663-6	8612

7590

06/13/2006

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EXAMINER
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HARPER, TRAMAR YONG

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/728,351		MILLER, RANDY	
	<b>Examiner</b>		<b>Art Unit</b>	
	Tramar Harper		3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Progressive Jackpot" was not disclosed in the Specification. The Specification does not teach the use of a progressive jackpot or a method of playing with multiple players.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by the US Patent of Walker (6,312,332).**

**Claim 1:** Walker discloses a video poker game, in which a player places a wager and a game of video poker is initiated (Col. 12:30-32). If the final hand matches any of the bonus hands indicated in the bonus database and displayed on the gaming apparatus a

bonus is initiated (Col. 12:52-56; Fig. 5). The bonus initiating hands are also amongst the bonus hands needed to be obtained within the bonus (Col. 12:61-64; Col. 13:7-12). If a bonus initiating hand is obtained bonus play timers are initiated and player(s) must obtain a predetermined number of bonus hands within the predetermined time period. Upon the bonus winning outcome a player is awarded a bonus payout (Col. 13:49-53).

**Claims 2-7:** Walker's video poker game comprises of visual indicators of the bonus payout and the bonus timers. Once the bonus game is initiated the indicators are displayed and remain active until the bonus is won or there is no bonus time remaining (Col. 13:12-13, 55-58; Figs. 5 & 11C).

**Claims 8-11:** If the final hand matches any of the bonus hands indicated in the bonus database and displayed on the gaming apparatus a bonus is initiated (Col. 12:52-56; Fig. 5). If a bonus initiating hand is obtained bonus play timers are initiated. In the embodiment anyone of the bonus initiating hands can initiate the bonus timer, but modifications such as limiting the activation of the timer to only one bonus hand is within the scope of the above teachings. Figure 5 illustrates a plurality of bonus timers with different values (Col. 13:6-11).

**Claims 12-15:** Walker discloses that the above teachings apply video poker, video blackjack, or video keno.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the US Patent of Walker (6,312,332) in view of the US Patent of Stupak (5,851,147).**

**Claims 16-17:** Walker teaches all the limitations as taught above, except the use of a first payout display. Walker discloses that the first payout is determined by using a payout table derived from the payout database (Col. 12-49-51). Also, Fig. 5 illustrates the display of the enhanced payout table, which is also cleared when a bonus is not commencing. It is known in the art to display a payout table in video poker. Stupak discloses a gaming apparatus that display payouts from 1-4 coins played and a jackpot or enhanced payout with a max of 5 coins wagered (Fig. 1, Col. 7:15-21). It would have been obvious of one of ordinary skill at the time of invention to modify the gaming apparatus such that the base payout display is displayed as well as the bonus payout display, as taught by Stupak. Providing a payout table give the player the feeling of winning potential earnings prior to playing the game.

**Claims 18-19, 24-26:** It is conventional in the art that players receive a certain percentage or multiple earnings based on the amount waged and/or the profit gained by the sponsor. Walker does not disclose that the potential bonus earnings are 25,000, 100,000, 250,000, or 1,000,000 times the amount wagered. Stupak discloses a video poker game where the earnings are more than 250,000 times the amount wagered (Fig. 6). It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify Walker's bonus such that the potential bonus winnings at least 250,000 times the wager, as disclosed by Stupak. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify Walker's invention, as stated above, because Applicant has not disclosed that such a modification provides an advantage, is used for a particular purpose, or solves a stated problem.

Therefore, it would have been prima facie obvious to modify Walker to obtain the invention as specified in claims 18-19, 24-26 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Walker.

**Claim 20:** Walker discloses linked gaming machines with progressive jackpots (Col. 1:56-59).

**Claim 21:** Fig. 5 illustrates the use of the decrementing timer (Col. 13:12-13).

**Claims 22-23:** Stuka's video poker game displays at least 4 enhanced payouts and a payout for identical cards (Fig. 1).

### ***Conclusion***

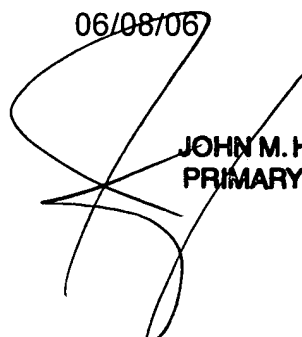
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US Patent of Acres (6,231,445) discloses a initiated bonus event with a decrementing timer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH

06/08/06  
  
**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**